

ESTTA Tracking number: **ESTTA718518**

Filing date: **01/05/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | |
|---------------------------------------|---|
| Name | HRHH IP, LLC |
| Granted to Date of previous extension | 01/06/2016 |
| Address | 200 Vesey Street, 11th Floor Three World Financial Center New York, NY 10281-1021 UNITED STATES |

| | |
|----------------------------|---|
| Correspondence information | Jill M. Pietrini Sheppard Mullin Richter & Hampton LLP 1901 Avenue of the Stars, Suite 1600 Los Angeles, CA 90067 UNITED STATES jpietrini@smrh.com, baigboboh@smrh.com, wwalters-sachs@smrh.com, ppost@smrh.com, shwang@smrh.com, mdanner@smrh.com, rwalsh@smrh.com, lmartin@smrh.com Phone:310-228-3700 |
|----------------------------|---|

Applicant Information

| | | | |
|------------------------|--|------------------------|------------|
| Application No | 86605795 | Publication date | 09/08/2015 |
| Opposition Filing Date | 01/05/2016 | Opposition Period Ends | 01/06/2016 |
| Applicant | Oyler, James Andrew 1135 NE 53RD ST KANSAS CITY, MO 64118 UNITED STATES | | |

Goods/Services Affected by Opposition

Class 042. First Use: 0 First Use In Commerce: 0


All goods and services in the class are opposed, namely: Providing an interactive website featuring technology that allows users to upload and share music and music videos, vote for their favorite artists, provide information regarding upcoming artist performances, provide commentary on live, recorded or uploaded music and music videos, view live or prerecorded performances, interviews, and special events, to purchase tickets for artist performances, and to purchase artist or website merchandise

Grounds for Opposition

| | |
|--------------------------------------|-----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Dilution | Trademark Act section 43(c) |

Marks Cited by Opposer as Basis for Opposition

| | | | |
|------------------|----------|------------------|------------|
| U.S. Application | 86473371 | Application Date | 12/06/2014 |
|------------------|----------|------------------|------------|

| | | | |
|---------------------|---|-----------------------|------|
| No. | | | |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | VINYL | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 035. First use: First Use: 2012/08/24 First Use In Commerce: 2012/08/24 Promoting, marketing, and advertising live musical performances and theatrical performances of others | | |

| | | | |
|----------------------|--|-----------------------|------------|
| U.S. Application No. | 86473372 | Application Date | 12/06/2014 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | VINYL | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 041. First use: First Use: 2012/08/24 First Use In Commerce: 2012/08/24 Arranging and conducting of concerts; concert booking; entertainment services, namely, live musical performances, comedy performances, and theatrical performances; provision of information relating to live performances, road shows, live stage events, theatrical performances, live music concerts and audience participation in such events; entertainment services, namely, conducting contests; nightclub services | | |

| | | | |
|----------------------|----------|-----------------------|------------|
| U.S. Application No. | 86473373 | Application Date | 12/06/2014 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | VINYL | | |

| | |
|---------------------|---|
| Design Mark |  |
| Description of Mark | NONE |
| Goods/Services | Class 043. First use: First Use: 2012/08/24 First Use In Commerce: 2012/08/24 Bar services; restaurant services; providing general purpose facilities for concerts, comedy shows, expositions, and other events and functions |

| | | | |
|----------------------|----------|-----------------------|------------|
| U.S. Application No. | 86473374 | Application Date | 12/06/2014 |
| Registration Date | NONE | Foreign Priority Date | NONE |


| | |
|-----------|-----------------|
| Word Mark | VINYL LAS VEGAS |
|-----------|-----------------|


| | |
|-------------|---|
| Design Mark |  |
|-------------|---|

| | |
|---------------------|--|
| Description of Mark | The mark consists of "VINYL LAS VEGAS" within the shape of a circle. |
|---------------------|--|

| | |
|----------------|---|
| Goods/Services | Class 035. First use: First Use: 2012/08/24 First Use In Commerce: 2012/08/24 Promoting, marketing, and advertising live musical performances and theatrical performances of others |
|----------------|---|

| | | | |
|----------------------|----------|-----------------------|------------|
| U.S. Application No. | 86473375 | Application Date | 12/06/2014 |
| Registration Date | NONE | Foreign Priority Date | NONE |

| | | | |
|----------------------|--|-----------------------|------------|
| Word Mark | VINYL LAS VEGAS | | |
| Design Mark |  | | |
| Description of Mark | The mark consists of "VINYL LAS VEGAS" within the shape of a circle. | | |
| Goods/Services | Class 041. First use: First Use: 2012/08/24 First Use In Commerce: 2012/08/24 Arranging and conducting of concerts; concert booking; entertainment services, namely, live musical performances, comedy performances, and theatrical performances; provision of information relating to live performances, road shows, live stage events, theatrical performances, live music concerts and audience participation in such events; entertainment services, namely, conducting contests; nightclub services | | |
| U.S. Application No. | 86473376 | Application Date | 12/06/2014 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | VINYL LAS VEGAS | | |

| | |
|---------------------|--|
| Design Mark |  |
| Description of Mark | The mark consists of "VINYL LAS VEGAS" within the shape of a circle. |
| Goods/Services | Class 043. First use: First Use: 2012/08/24 First Use In Commerce: 2012/08/24 Bar services; restaurant services; providing general purpose facilities for concerts, comedy shows, expositions, and other events and functions |

| | |
|-------------|---|
| Attachments | 86473371#TMSN.png(bytes) 86473372#TMSN.png(bytes) 86473373#TMSN.png(bytes) 86473374#TMSN.png(bytes) 86473375#TMSN.png(bytes) 86473376#TMSN.png(bytes) FINAL - [18th and Vinyl] Notice of Opposition.pdf(1646726 bytes) |
|-------------|---|

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|--------------------|
| Signature | /Jill M. Pietrini/ |
| Name | Jill M. Pietrini |
| Date | 01/05/2016 |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|---|---|
| <i>In re Matter of Application No. 86/605,795 for the mark: 18TH AND VINYL in Class 42</i> HRHH IP, LLC Opposer, vs. James Andrew Oyler, Applicant. | Opposition No. _____ NOTICE OF OPPOSITION |
|---|---|

Commissioner for Trademarks
ATTN: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451




Dear Commissioner:

Opposer, HRHH IP, LLC, a Delaware limited liability company, having its principal place of business at Brookfield Place, 250 Vesey Street, 15th Floor, New York, New York 10281-1023 (“Opposer”), believes that it will be harmed by the registration of the mark 18TH AND VINYL, as shown in U.S. Application Serial No. 86/605,795, in Class 42 (the “Application”), and hereby opposes its registration on the following grounds:

FACTUAL BACKGROUND REGARDING OPPOSER’S VINYL MARKS

1. Opposer is the entity responsible for operating the highly-successful live performance venue Vinyl Las Vegas at the Hard Rock Hotel & Casino Las Vegas in Las Vegas, Nevada. Attached hereto as **Exhibit A** are true and correct printouts from Opposer’s website at the domain <www.hardrockhotel.com> about Opposer and Vinyl Las Vegas.

2. Opposer owns the following trademark applications, filed on December 6, 2014, for the marks VINYL and VINYL & Design (the “VINYL Marks”):

| <u>MARK</u> | <u>SER. NO.</u> | <u>CLASS</u> | <u>GOODS/SERVICES</u> |
|---|------------------------|---------------------|---|
| VINYL | 86/473,371 | 35 | Promoting, marketing, and advertising live musical performances and theatrical performances of others |
| VINYL | 86/473,372 | 41 | Arranging and conducting of concerts; concert booking; entertainment services, namely, live musical performances, comedy performances, and theatrical performances; provision of information relating to live performances, road shows, live stage events, theatrical performances, live music concerts and audience participation in such events; entertainment services, namely, conducting contests; nightclub services. |
| VINYL | 86/473,373 | 43 | Bar services; restaurant services; providing general purpose facilities for concerts, comedy shows, expositions, and other events and functions. |
|  | 86/473,374 | 35 | Promoting, marketing, and advertising live musical performances and theatrical performances of others |
|  | 86/473,375 | 41 | Arranging and conducting of concerts; concert booking; entertainment services, namely, live musical performances, comedy performances, and theatrical performances; provision of information relating to live performances, road shows, live stage events, theatrical performances, live music concerts and audience participation in such events; entertainment services, namely, conducting contests; nightclub services. |
|  | 86/473,376 | 43 | Bar services; restaurant services; providing general purpose facilities for concerts, comedy shows, expositions, and other events and functions. |

3. Opposer first used the VINYL Marks for entertainment, restaurant, bar and related services as early as August 2012. Since then, Opposer has continuously used the VINYL Marks for its various entertainment and related services. Opposer’s Vinyl Las Vegas has hosted performances by up-and-coming and established national and international entertainers, and

other entertainment-related events including award shows. Opposer offers tickets to live events held at Vinyl Las Vegas, including musical performances, through its website and at its box office. Opposer advertises and markets Vinyl Las Vegas and the VINYL Marks extensively including, but not limited to, through its social media accounts available through Facebook, Twitter and Instagram. Vinyl Las Vegas has received considerable media attention. As such, Opposer has developed common law rights in the VINYL Marks which predate the Application.

FACTUAL BACKGROUND REGARDING THE APPLICATION

4. On April 22, 2015, Applicant James Andrew Oyler, an individual, having an address of 1135 NE 53rd St. 1135, Kansas City, Missouri 64118 (“Applicant”), filed the Application in the Office seeking registration, on an intent-to-use basis, of 18TH AND VINYL for use with an “interactive website featuring technology that allows users to upload and share music and music videos, vote for their favorite artists, provide information regarding upcoming artist performances, provide commentary on live, recorded or uploaded music and music videos, view live or prerecorded performances, interviews, and special events, to purchase tickets for artist performances, and to purchase artist or website merchandise” in Class 42.

5. The Application was published for opposition in the Official Gazette on September 8, 2015. Opposer was granted extensions of time to oppose the Application.

FIRST GROUND – LIKELIHOOD OF CONFUSION

6. Opposer incorporates the allegations contained in Paragraphs 1 to 5 herein.
7. Applicant’s proposed mark is confusingly similar to the VINYL Marks.
8. Applicant’s mark is likely to cause confusion, mistake, or deception as to the source, origin, affiliation, association, connection, or sponsorship of Applicant’s services to be offered under the 18TH AND VINYL mark with the VINYL Marks, Vinyl Las Vegas, the Hard Rock Hotel & Casino Las Vegas, and/or with Opposer or Opposer’s activities.

SECOND GROUND – LIKELIHOOD OF DILUTION

9. Opposer incorporates the allegations contained in Paragraphs 1 to 8 herein.

10. The VINYL Marks are inherently distinctive and have acquired secondary meaning and are associated with Opposer and the services offered under the VINYL Marks. The VINYL Marks are famous within the meaning of the Federal Trademark Dilution Act. Applicant filed the Application after the VINYL Marks had become famous, and Applicant seeks to commercially use the applied-for mark 18TH AND VINYL.

11. Applicant's mark is likely to cause dilution of Opposer's VINYL Marks and blur the distinctiveness of Opposer's VINYL Marks.

DAMAGE TO OPPOSER

12. As a result of all of the foregoing, the maturation of the Application into a registration would cause a likelihood of confusion, mistake, or deception with Opposer and Opposer's VINYL Marks, and a likelihood of dilution of, Opposer's VINYL Marks.

13. Opposer would be damaged by the registration of the mark shown in the Application, in that such registration would give Applicant a *prima facie* exclusive right to the use of 18TH AND VINYL, despite the likelihood of confusion, mistake, or deception with Opposer and Opposer's VINYL Marks, and likelihood of dilution described above.

PRAYER

WHEREFORE, Opposer prays that this Opposition be sustained in favor of Opposer, that the Application be rejected, and that registration of the Application be refused.

Please charge the requisite \$300 opposition filing fee and any additional amounts to Deposit Account No. 50-5691. A duplicate copy of this Notice of Opposition is enclosed for this purpose.

Respectfully submitted,

Dated: January 5, 2016

/Jill M. Pietrini
Jill M. Pietrini
Benjamin O. Aigboboh
SHEPPARD MULLIN RICHTER & HAMPTON LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, California 90067-6017
(310) 228-3700

Attorneys for Opposer HRHH IP, LLC

CERTIFICATE OF SERVICE

I hereby certify that this Notice of Opposition is being deposited with the United States Postal Service, postage prepaid, first class mail, in an envelope addressed to:

James Andrew Oyler
1135 NE 53rd St.
Kansas City, Missouri 64118

on this 5th day of January, 2016.

/LaTrina A. Martin/

LaTrina A. Martin

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically to Commissioner of Trademarks, Attn: Trademark Trial and Appeal Board, through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 5th day of January, 2016.

/LaTrina A. Martin/

LaTrina A. Martin

SMRH:473926310.2

EXHIBIT A



STAY DINE ENTERTAINMENT GAME PARTY RELAX SHOP BACKSTAGE PASS EVENTS BLOG MEETINGS DESTINATIONS

BACKSTAGE PASS
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☐ Get Backstage Pass Rewards Club Discount

BOOK NOW

**BEST
RATE
GUARANTEE**

Book on our website to get the lowest rates!

VINYL

SMALL VENUE, BIG TALENT.

Stop by our box office with your Nevada ID for
NO SERVICE FEES on all Vinyl Shows!

Vinyl Photos

(Click to see larger photos)



[See more images ▶](#)

Events



The Cowboy Mashup Music Show
Vinyl | 9:00 P.M. | No Cover | Ages 6+
December 08, 2015 at



National Finals Rodeo Viewing Party
Vinyl | 5:30 P.M. | No Cover | Ages 6+
December 08, 2015 at



Seth Turner and the High Desert Drifters
Vinyl | 9:00 P.M. | No Cover | Ages 6+
December 09, 2015 at



National Finals Rodeo Viewing Party
Vinyl | 5:30 P.M. | No Cover | Ages 6+
December 09, 2015 at

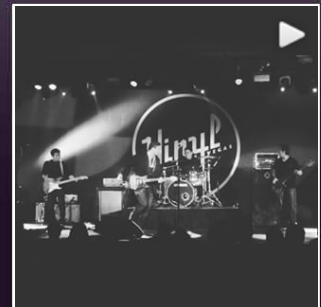


Thrillbilly Deluxe
Vinyl | 9:00 P.M. | No Cover | Ages 6+
December 10, 2015 at

ALL EVENTS AT VINYL

Meetings & Private Events

Specials



Vinyl Las Vegas on Instagram

Box Office Hours

10:00 am to 8:00 pm Daily
Closed the 15th of each month from 1pm to 2pm
Tel: [702.693.5000](tel:702.693.5000) ext. 6914

Contact

4455 Paradise Road
Las Vegas, NV 89169
Box Office: [702.693.5000](tel:702.693.5000) ext 6914
Send us an email: nylvip@hrhvegas.com

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- 2 NIGHT STAY IN A LUXURIOUS HRH SUITE



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Tuesday Dec 08, 2015



The Cowboy Mashup Music Show

VINYL | 9:00 P.M. | NO COVER | AGES 6+

NO COVER

[See Event Details](#)

[Vinyl](#)



National Finals Rodeo Viewing Party

VINYL | 5:30 P.M. | NO COVER | AGES 6+

NO COVER

[See Event Details](#)

[Vinyl](#)

Wednesday Dec 09, 2015



Seth Turner and the High Desert Drifters

VINYL | 9:00 P.M. | NO COVER | AGES 6+

NO COVER

[See Event Details](#)

[Vinyl](#)



National Finals Rodeo Viewing Party

VINYL | 5:30 P.M. | NO COVER | AGES 6+

NO COVER

[See Event Details](#)

[Vinyl](#)

Thursday Dec 10, 2015



Thrillbilly Deluxe

VINYL | 9:00 P.M. | NO COVER | AGES 6+

NO COVER

[VIEW ALL
UPCOMING
CONCERTS](#)

[Visit Official Website](#)

[See Event Details](#)

[Vinyl](#)



National Finals Rodeo Viewing Party

VINYL | 5:30 P.M. | NO COVER | AGES 6+

NO COVER

[See Event Details](#)
[Vinyl](#)

Friday Dec 11, 2015



American Voodoo

VINYL | 9:00 P.M. | NO COVER | AGES 6+



NO COVER

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UPCOMING
CONCERTS[See Event Details](#)
[Vinyl](#)

National Finals Rodeo Viewing Party

VINYL | 5:30 P.M. | NO COVER | AGES 6+

NO COVER

[See Event Details](#)
[Vinyl](#)

Saturday Dec 12, 2015

American Icon: Johnny Cash Tribute Starring
Doug Allen Nash

VINYL | 9:00 P.M. | NO COVER | AGES 6+

[Visit Official Website](#)

NO COVER

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UPCOMING
CONCERTS[See Event Details](#)
[Vinyl](#)

National Finals Rodeo Viewing Party

VINYL | 5:30 P.M. | NO COVER | AGES 6+

NO COVER

[See Event Details](#)
[Vinyl](#)

Tuesday Dec 15, 2015

bMuse – The World's Most Authentic Tribute
to Muse

VINYL | 10:00 P.M. | NO COVER | AGES 6+

NO COVER

VIEW ALL
UPCOMING
CONCERTS[See Event Details](#)
[Vinyl](#)

Wednesday Dec 16, 2015

EKOH w/ Almost Normal, Avalon Landing,
Gregory Michael Davis

VINYL | 7:00 P.M. | AGES 6+

BUY TICKETS

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CONCERTS[See Event Details](#)
[Vinyl](#)

Thursday Dec 17, 2015

RVLTN presents CIRCUIT: Party Thieves w/
Bombmakers, Sloves, Andrew Stolle

VINYL | 9:00 P.M. | AGES 6+

BUY TICKETS

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UPCOMING
CONCERTS[See Event Details](#)
[Vinyl](#)

Friday Dec 18, 2015



High Voltage – The Las Vegas AC/DC
Production Show
VINYL | 9:00 P.M. | NO COVER | AGES 6+

NO COVER

[See Event Details](#)[Vinyl](#)

Saturday Dec 19, 2015



Sin City Sinner's – Christmas in Vegas
Spectacular! w/ All Star Special Guests
VINYL | 8:00 P.M. | NO COVER | AGES 6+

NO COVER

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UPCOMING
CONCERTS](#)[See Event Details](#)[Vinyl](#)

Sunday Dec 20, 2015



104.3 NOW FM presents JAKE MILLER w/
Los 5
VINYL | 6:00 P.M. | AGES 6+

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UPCOMING
CONCERTS](#)[See Event Details](#)[Vinyl](#)

Saturday Dec 26, 2015



Holiday Throwdown Otherwise w/ Conflict of
Interest & more
VINYL | 8:00 P.M. | AGES 6+

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CONCERTS](#)[See Event Details](#)[Vinyl](#)

Sunday Jan 10, 2016



The Fighter & The Kid Live with Brendan
Schaub & Bryan Callen
VINYL | 7:00 P.M. | 18+ WITH VALID ID

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UPCOMING
CONCERTS](#)[See Event Details](#)[Vinyl](#)

Monday Jan 25, 2016



Mondays Dark with Mark Shunock
VINYL | 8:30 PM | AGES 6+

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OTHERWISE W/ SPECIAL GUESTS

SAT, DEC 26 | 8PM DOORS | ALL AGES

BUY TICKETS <



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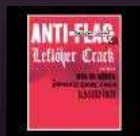
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Sunday Feb 28, 2016



Anti-Flag & Leftover Crack w/ War on
Women, Homeless Gospel Choir, Blackbird
RauM

VINYL | 6:30 P.M. | AGES 6+

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Friday Mar 18, 2016



Nonpoint with special guests

VINYL | 8:00 P.M. | AGES 6+

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